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OFFICE OF PETITIONS

In re Application of: :
Ellenbogen et al. :
Application No. 10/677,976 : ON PETITION
Filed: October 2, 2003 :
PGPUB: US20040120454A1 6/24/04. :
Docket No.: 25960-009 :

This is a decision on the petition filed January 12, 2005, under 37 CFR 1.182 asking, pursuant to a court order to petitioner, that the USPTO withdraw the request for a corrected filing receipt filed December 2, 2004, and reinstitute the claim for benefit of provisional application No. 60/415,491.

The petition is **dismissed as immaterial**.

As background, the above-identified non provisional application claimed benefit (by way of the declaration under 37 CFR 1.63 present on filing) under 35 U.S.C. § 119(e) of prior provisional application No. 60/415,391 filed October 2, 2002.

This priority claim was recognized by the USPTO as shown by its entry under the caption "Domestic Priority Data" on the filing receipt mailed December 29, 2003, the updated filing mailed March 15, 2004, and the appropriate entry on corresponding U.S. Patent Application Publication No. US20040120454A1 published June 24, 2004.

In due course, on December 2, 2004, applicants filed a request for cancellation of the aforementioned claim for benefit, and a request for issuance of a corrected filing receipt to that effect.

The USPTO acknowledged applicants' request for cancellation of the priority claim on December 14, 2004, as evidenced by the corrected filing receipt mailed that date which reflected that no domestic priority benefit was claimed.

However, during litigation at the state level In Massachusetts, the court issued a preliminary injunction on January 10, 2005, directing applicants to, forthwith, withdraw the above-noted request for a corrected filing receipt, which translates into applicants' reassertion of the § 119(e) claim for benefit as the USPTO had already acted on the cancellation.

The instant petition was filed January 12, 2005.

Petitioner requests that the USPTO, under 37 CFR 1.182: (1) grant petitioners' request for a corrected filing receipt and, as such, the corrected filing receipt should again reflect a § 119(e) benefit claim of the aforementioned provisional application, (2) withdraw petitioners' request for cancellation of their benefit claim of the '391 provisional application, and (3) take any additional steps required to effectuate the foregoing withdrawal.

By its terms, 37 CFR 1.182 applies only when no other regulation speaks to the issue. However, 37 CFR 1.78(a)(6) specifically governs the circumstances of this case. As a result of the American Inventor's Protection Act of 1999, 37 CFR 1.78 was amended to provide a time period within which a claim to the benefit of a prior provisional application must be stated or waived, and to also provide a mechanism by which a belated claim could be remedied. The Office will not grant petitioner's request for a corrected filing receipt to include a benefit claim unless the proper reference to the prior application is included in the first sentence of the specification or an ADS within the time period required by 37 CFR 1.78(a). Here, petitioners were fortunate that the USPTO picked up their §119(e) claim as it was not presented in either the first line of the specification, or in an ADS, as required by 37 CFR 1.78(a)(5)(iii). The reference to prior provisional was not submitted in either the first line of the specification or in an ADS within the later of four months from the actual filing date of the instant application (which was February 2, 2004) or sixteen months from the filing date of the prior-filed provisional application (which again was February 2, 2004) as required by 37 CFR 1.78(a)(5)(ii). Indeed, the date that the required reference to the provisional application was first filed herein is January 12, 2005, by way of the supplemental amendment filed that date, which is far beyond the time periods set forth in 37 CFR 1.78(a). Further, as petitioners themselves cancelled their claim for benefit on December 2, 2004, there is a hiatus in claiming § 119(e) benefit from then to January 12, 2005. As noted in MPEP 201.11(F), petitioner's must now proceed under 37 CFR 1.78(a)(6) in their quest for a corrected filing receipt; 37 CFR 1.182 is inapposite. It should be noted that 37 CFR 1.182 is not a mechanism for avoiding the requirements of the established rules and procedures. See Hicks v. Costello, 1903 Dec. Comm'r Pat. 123, 125 (1903).

In any forthcoming petition under 37 CFR 1.78(a)(6), given petitioner's express cancellation of the §119(e) claim for benefit of the provisional application, and in order to facilitate USPTO consideration of their petition, petitioners may wish to include a discussion in their petition of the following caveat noted in MPEP 201.11(G):

A cancelation of a benefit claim to a prior application may be considered as a showing that the applicant is intentionally waiving the benefit claim to the prior application in the instant application. If the applicant later files a petition to accept an unintentionally delayed claim to add the benefit claim to the prior application in the same application from which the benefit claim was canceled, the Office may refuse to accept such benefit claim because the delay was not unintentional.

In other words, petitioners must explain in their forthcoming petition why the USPTO should not refuse to accept their belated benefit claim. That is, petitioners' deliberate December 2, 2004, cancellation of the § 119(e) benefit claim is reasonably be considered to show that petitioners intentionally as opposed to accidentally, inadvertently, or through negligence, waived their § 119(e) benefit claim to the prior provisional application. It is further noted that as the requirement that the amendment presenting the § 119(e) benefit claim be "unintentionally delayed" is statutory, it is not subject to waiver by the USPTO. See 35 U.S.C. § 119(e).

It is noted that the injunction, while instructing applicants to reinsert the claim for benefit in aid of the other litigant, also permitted applicants to file any continuing application with any benefit claim that they wished. It is respectfully observed, however, that unless and until a forthcoming petition under 37 CFR 1.78(a)(6) is granted in this application, petitioners continue to have waived any § 119(e) benefit of the provisional application in this application. Accordingly, the filing receipt issued December 14, 2004, properly stands as correctly reflecting the current status of any § 119(e) benefit claim herein.

This, in turn, means that any application—including any continuing application claiming § 120 benefit of this application-- that was not filed within 12 months of the filing date of provisional application No. 60/415,391, or any application that does not claim § 120 benefit of an application that was filed within 12 months of the filing date of provisional application No. 60/415,391 simply **cannot** claim § 119(e) benefit of the '391 application. Rather, such is and remains precluded by operation of law. In other words, the instant application can not be part of any chain of later filed continuing applications that seeks to claim benefit of the provisional application, as this application, while filed within 12 months of the provisional application, now breaks the chain of § 119(e) priority benefit of the provisional. Any other application that was not filed on or before October 2, 2003, or does not claim 35 U.S.C. § 120 benefit of an application filed on or before October 2, 2003, that itself properly claims benefit of the provisional application (*i.e.*, other than this intermediate application) may not properly claim benefit of provisional application No. 60/415,391.

Petitioners should promptly submit, in any such affected application(s), the necessary conforming amendments to their benefit claim(s), which may impact the number and type of references or rejections available to the examiner(s), and should also bring to the attention of those examiner(s) a copy of this decision, as well as a copy of any decision(s) on the forthcoming petition(s) under 37 CFR 1.78(a)(6).

The forthcoming petition under 37 CFR 1.78(a)(6) should be addressed as follows:

By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: Customer Service Window
 Randolph Building 401 Dulany Street
 Alexandria, VA 22314:

By fax: (703) 872-9306
 ATTN: Office of Petitions

Telephone inquiries related to this communication should be directed to the undersigned at (571) 272-3217.



Brian Hearn
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Office of the Deputy Commissioner for
Patent Examination Policy